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| 10/043,837 | 01/09/2002 | Yoshio Ikura | MAT-8221US | 1180 |

|  | EXAMINER |
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| 7590          04/24/2006 | ADHAMI, MOHAMMAD SAJID |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2616 |  |

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/043,837 | IKURA, YOSHIO |
| | **Examiner** | **Art Unit** | |
| | Mohammad S. Adhami | 2616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on 21 February 2006.

2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 3-8* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

## DETAILED ACTION

- Applicant's Amendment filed 2/21/2006 is acknowledged.

- Claims 1,3, and 8 have been amended.

- Claim 2 has been cancelled

- Claims 1,3-8 are pending

### *Claim Objections*

1.      Claim 6 is objected to because of the following informalities:  Claim 6 is shown to depend from claim 2; however, it should depend from claim 1.  Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

1.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.      Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

      Claim 1 recites "a conversion unit for converting said IP packet to said voice signal and for converting said voice signal." What is the said voice signal converted to?

      Claims 3-8 are rejected because they depend from claim 1.

3.      Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.  In claim 4 the language "an IP address of a call

destination from said standard telephone" is unclear.  How does a standard telephone

give an IP address?

Claim 5 is rejected because it depends from claim 4.

### Claim Rejections - 35 USC § 103

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Itoi (US 6,456,625) in view of Elliot (US 6,754,181).

**Re claims 1 and 3** (as best understood):

Itoi discloses "a terminal interface to which a terminal is connected"

(Figure 3B reference number 312 is a terminal interface and reference number

313 is a terminal),

Itoi further discloses "a line interface connected to said network" (Figure

3B reference number 323 is a line interface that connected to network 102).

Itoi further discloses "a communication function unit for controlling a voice

signal and an IP packet transmitted through said terminal interface and said line

interface" (Figure 3B reference number 322 and Col.9 lines 10-12 "A call control

module 322...controls calls concerning the respective analog telephone

sets...and internet phone devices" and Col.9 lines 10-12 *A call control module*

*322 controls call concerning the analog telephone set and internet phone*

*devices*).

Itoi further discloses "a conversion unit for converting said IP packet to

said voice signal and for converting said voice signal" (Figure 3B reference

number 309 and Col.9 lines 52-57 "the A/D conversion module 309...executes

the analog-to-digital/digital-to-analog conversions of speech signals concerning

this analog telephone set...and packet disassembling/assembling processes for

digital speech signals").

Itoi further discloses "a connection establishing unit for establishing a

connection between said terminal and another terminal connected to said

network, by allowing said communication function unit to transmit to said network

an IP datagram including an IP address of said concentrator and said IP packet"

(Col.9 lines 40-45 "the address unit...automatically gives the data terminal...the

set of the local IP address and TCP/UDP port number. As a results, the data

terminal...is permitted to join in the LAN...and data communication over the data

terminal...is actualized in the LAN").

Itoi does not explicitly disclose "a determining unit for determining whether

or not said terminal connected to said terminal interface is capable of an IP

communication, wherein...when said determining unit determines that said

terminal is capable of the IP communication, an IP packet input from said line interface is outputted to said terminal interface, and an IP packet input from said terminal interface is outputted to said line interface; and...when said determining unit determines that said terminal is not capable of the IP communication, the IP packet input from said line interface is converted to a voice signal by said conversion unit and outputted to said terminal interface, while said voice signal input from said terminal interface is converted to an IP packet and outputted to said line interface" and "wherein when said terminal connected to said terminal interface is a standard telephone, it is determined that said terminal is not capable of IP communication.

Elliot discloses "a determining unit for determining whether or not said terminal connected to said terminal interface is capable of an IP communication" (Col.89 lines 14-17 "A PC and a telephone is used to receive and make calls. In this case, a user profile will contain information that allows the DAP and Directory Service to make a determination whether to send an incoming call to the PC or to the telephone" where if the call is determined to be sent to a PC it is IP capable and when there is a telephone the terminal is not IP capable).

Elliot further discloses "when said determining unit determines that said terminal is capable of the IP communication, an IP packet input from said line interface is outputted to said terminal interface, and an IP packet input from said terminal interface is outputted to said line interface" (Col.75 lines 53-56 "The

called user can answer the phone with a mouse click and the calling party then beings sending traffic directly to the IP address of the called party").

Elliot further discloses "when said determining unit determines that said terminal is not capable of the IP communication, the IP packet input from said line interface is converted to a voice signal by said conversion unit and outputted to said terminal interface, while a voice signal input from said terminal interface is converted to an IP packet and outputted to said line interface" (Col.92 lines 7-11 "the ITG provides services to convert the IP packetized voice from the PC to voice over the PSTN. Similarly, the ITG will take the voice from the PSTN and convert it to the IP packetized voice for the PC").

Itoi and Elliot are analogous because they both pertain to voice over Internet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoi to include the above discussed limitations in the network as taught by Elliot in order to accommodate IP capable and non-IP capable terminals into a hybrid network and enable determination of each.

**Re claim 4** (as best understood):

Itoi discloses "wherein by receiving a dialing of the standard telephone as an IP address of a call destination, the connection to a terminal having the IP address of the call destination is established" (Col. 1 lines 46-50 "a party to be talked to over the internet phone is designated by any of a scheme wherein the LAN address (IP address) and a domain name are used as they are, a scheme

wherein a number registered and managed on the internet phone side

beforehand is dialed" and Col.3 lines 52 –55 "the analog telephone set is

permitted to join in the LAN telephone network, and speech over the analog

telephone set is actualized in the LAN telephone network).

**Re claim 5** (as best understood):

Itoi discloses "when the connection is established, said concentrator

transmits the IP datagram including the IP address of said concentrator to the

terminal having the IP address of the call destination" (Col.7 lines 51-53 "A

common global IP address is a LAN address (IP address) which is given to the

LAN telephone switching apparatus").

**Re claim 6:**

As disccused above, Itoi meets all the limitations of the parent claims.

Itoi does not explicitly disclose "wherein when said terminal connected to

said terminal interface is a computer, it is determined that said terminal is

capable of an IP communication."

Elliot discloses "a determining unit for determining whether or not said

terminal connected to said terminal interface is capable of an IP communication"

(Col.89 lines 14-17 "A PC and a telephone is used to receive and make calls.  In

this case, a user profile will contain information that allows the DAP and Directory

Service to make a determination whether to send an incoming call to the PC or to

the telephone" where if the call is determined to be sent to a PC it is IP capable

and when there is a telephone the terminal is not IP capable).

Itoi and Elliot are analogous because they both pertain to voice over Internet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoi to include the above discussed limitations in the network as taught by Elliot in order to incorporate a computer terminal into the hybrid telephony network of Itoi.

**Re claim 7:**

As disccused above, Itoi meets all the limitations of the parent claims.

Itoi does not explicitly disclose "wherein said concentrator allows an IP datagram transmitted from said computer pass as it is, to a terminal having an IP address designated by said computer."

Elliot further discloses "wherein said concentrator allows an IP datagram transmitted from said computer pass as it is, to a terminal having an IP address designated by said computer" (Col.79 lines 57-58 "no translation of IP encoded voice to PCM is required, indeed the dial out will use TCP/IP over PPP." OR Col.75 lines 53-56 "The called user can answer the phone with a mouse click, and the calling party then begins sending traffic directly to the IP address of the called party").

Itoi and Elliot are analogous because they both pertain to voice over Internet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoi to include the above discussed limitations in the

network as taught by Elliot in order to incorporate a computer terminal into the

hybrid telephony network of Itoi.

6.      Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi in

view of Elliot as applied to claim 7 above, and further in view of Nadeau (US 6,240,449).

**Re claim 8:**

As disccused above, Itoi meets all the limitations of the parent claims.

Itoi does not explicitly disclose "wherein when said computer establishes a

connection, said concentrator transmits an IP datagram including said IP address

which is an IP address of said computer to a said another terminal having said IP

address designated by said computer."

Elliot discloses "wherein when said computer establishes a connection,

said concentrator transmits an IP datagram including said IP address which is an

IP address of said computer to another terminal having said IP address

designated by said computer" (Col.93 lines 3-4 "The software package sends a

message to a directory service to register the computer" where the message

contains 40-43 "The IP address identifying the port that is being used to connect

this computer to the network.  This address will be used by other IP telephony

software packages to establish a connection to this computer.").

Itoi and Elliot are analogous because they both pertain to voice over

Internet.

It would have been obvious to one of ordinary skill in the art at the time of

the invention to modify Itoi to include the above discussed limitations in the

network as taught by Elliot in order to incorporate a computer terminal into the

hybrid telephony network of Itoi.

Itoi does not explicitly disclose "sending an IP address of said computer to

a terminal having the IP address designated by said computer."

Nadeau discloses "sending an IP address of said computer to a terminal

having the IP address designated by said computer" (Col.10 lines 45-47 "the

solution was for the caller to send an e-mail message to the called party including

the caller's own IP address").

Itoi and Nadeau are analogous because they both pertain to voice over

internet and communication between a standard telephone and an IP telephone.

It would have been obvious to one of ordinary skill in the art at the time of

the invention to modify Itoi to include sending the caller's IP address to the

destination as taught by Nadeau in order to establish a call.

### Response to Arguments

7.      Applicant's arguments with respect to claim 2/21/2006 have been considered but

are moot in view of the new ground(s) of rejection.

The Remarks concerning the disclosure of Itoi are moot in view of the new

grounds of rejection.

8.      Applicant's arguments filed 2/21/2006 have been fully considered but they are

not persuasive.

On pg.6 of the Remarks section of the Amendment filed 2/21/2006, the
Applicant contends that Elliot does not determine whether the terminal is a PC or
a telephone.

The Examiner respectfully disagrees. As cited previously, Col.89 lines 14-
17 show determining whether the terminal is a PC or a telephone. The Dap and
Directory Service would not be able to correctly route a call if they did not
determine whether the terminal was a PC or a telephone.

Elliot further discloses determining whether the terminal is a PC or a
telephone on Col.89 lines 47-48 ("A PC to phone call where a directory service is
queried to determine that the terminating VNET is a phone").

### Conclusion

9.      The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. Chung (US App. 2003/0002476) shows sending the calling
parties IP address to the destination terminal.

10.     Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad S. Adhami whose telephone number is

(571)272-8615.  The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hassan Kizou can be reached on (571)272-3088.  The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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MSA 4/17/2006

HASSAN KIZOU
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